

Serial No. 10/643,383

Amend. In Resp. to Off. Act. of Mar. 23, 2005

UTILITY PATENT

B&D No. TN2491A

REMARKS

Applicants have amended Claim 11. Claims 11-13 therefore are pending in the present application.

The Examiner has rejected Claims 11-13 under 35 USC § 112, second paragraph, for indefiniteness. In particular, the Examiner noted that Claim 11 was an incomplete sentence.

In response, Applicants have added the language that was in original Claim 11 as filed on August 19, 2003 and in the parent application. Therefore, no narrowing amendment has occurred.

The Examiner also rejected Claims 11-13 under 35 USC § 103(a) as being unpatentable over US Patent No. 3,810,790 ("Denis") in view of US Patent No. 4,322,597 ("Hooke").

Reconsideration and withdrawal of this rejection is respectfully requested.

Claim 11, as amended, calls for a method for manufacturing a battery pack comprising the steps of providing a housing and two cells, at least one cell having a weld area, welding a strap between the two cells, and disposing the cells in the housing, wherein the strap is welded by disposing a first electrode on the strap outside of the weld area and a second electrode on the at least one cell outside of the weld area, and providing a current between the first and second electrodes.

Admittedly, Denis teaches a method for manufacturing a battery pack including the steps of providing two cells, at least one cell having a weld area, welding a strap between the two cells via two electrodes, and providing a current between the two electrodes. However, Denis does not

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disclose disposing a first electrode on the strap outside of the weld area and a second electrode on the at least one cell outside of the weld area.

The Examiner noted that electrode 15 was disposed outside of the weld area. While it is unclear whether electrode 15 is disposed outside of the weld area, such uncertainty is not found with electrode 14. Electrode 14 is disposed inside the weld area.

By contradistinction, Claim 11 requires "disposing a first electrode on the strap outside of the weld area and a second electrode on the at least one cell outside of the weld area." In other words, both electrodes must be disposed outside of the weld area. Because neither Denis nor Hooke disclose such placement, the Denis/Hooke combination cannot render unpatentable Claim 11 and its dependent claims.

Persons of ordinary skill in the art should understand that the amendment of Claim 11 to explicitly denote that both the first and second electrodes are disposed outside of the weld area is not a narrowing amendment. This is because the phrase "outside of the weld area" in the original claim language ("disposing a first electrode on the strap and a second electrode on the at least one cell outside of the weld area") was intended to modify the placement of both the first and second electrodes. The present amendment just makes explicit what was implicitly claimed. Therefore, no narrowing amendment has occurred that would give rise to prosecution history estoppel.

In view of the foregoing, Claims 11-13 are patentable and the application is believed to be in condition for formal allowance.

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No fee is believed due. Nevertheless, the Commissioner is authorized to charge payment of any fees due in processing this amendment, or credit any overpayment to Deposit Account No. 02-2548.

Respectfully submitted,



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